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10/032,110	12/19/2001	Vasant Balasubramanian	INTE0002	7027

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,110

Applicant(s)

BALASUBRAMANIAN, VASANT

Examiner

Jeffrey R. Swearingen

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to because the Examiner believes the drawings are confusing, unclear, do not adequately illustrate the claimed invention, and are of such poor visual quality as to cause the words in the drawings to be difficult to clearly read. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Art Unit: 2145

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

4. Claim 52 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 52 is dependent upon claim 54, which has not been submitted. The Examiner has made a reasonable attempt to guess what claim 52 is intended to be dependent on, and believes claim 52 to be dependent upon 43.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 22 rejected under 35 U.S.C. 102(e) as being anticipated by Maurille (U.S. Patent No. 6,484,196).
7. Regarding claims 1 and 22, Maurille describes a system and method comprising means for interfacing with a plurality of external communication systems of varying type; and a server, said server operative to create records that uniquely identify and link communication items created by a plurality of users within any of said external communication systems whereby a threaded trail of collaborative communication is created. [Maurille, Abstract, column 3, lines 2-15, column 4, lines 36-40] By this rationale claims 1 and 22 are rejected.

Claim Rejections - 35 USC § 103

Art Unit: 2145

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-3, 5-7, 12-16, 18, 23-24, 26-28, 33-37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille and Flanagan (*Java in a Nutshell*, 2nd edition, May 1997, pp. 17, 476-477).

10. Regarding claims 2 and 23, Maurille is applied as in claims 1 and 22. Maurille fails to disclose use of an API.

11. However, Flanagan discloses an API including threading capability. [Flanagan, 17, 476-477]

12. It would be obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Maurille and Flanagan for the purpose of performing many types of operations, including building a connector to an external system. Maurille gives motivation for the combination by stating that client and server applications are involved and requests are relayed between the two applications. [Maurille, column 3, lines 2-15] By this rationale claims 2 and 23 are rejected.

13. Regarding claims 3 and 24, Maurille and Flanagan are applied as in claims 2 and 23. Maurille further discloses methods for interacting with said external communication systems. [Maurille, column 3, lines 11-15] By this rationale claims 3 and 24 are rejected.

14. Regarding claims 5 and 26, Maurille and Flanagan are applied as in claims 2 and 23. Maurille further discloses accepting a request for an action from within said system and initiating said requested action in one of said external systems. [Maurille, column 3, lines 2-15] By this rationale claims 5 and 26 are rejected.

Art Unit: 2145

15. Regarding claims 6 and 27, Maurille and Flanagan are applied as in claims 2 and 23.

Maurille further discloses a threading server, with said record including a unique ID, title, description, type, original post ID, parent ID and item data. [Maurille, column 8, lines 21-66] By this rationale claims 6 and 27 are rejected.

16. Regarding claims 7 and 28, Maurille and Flanagan are applied as in claims 6 and 27.

Maurille further discloses a marker or string passed to a native external system for the purpose of interacting with the item. [Maurille, column 9, line 56 – column 11, line 7] By this rationale claims 7 and 28 are rejected.

17. Regarding claims 9 and 30, Maurille and Flanagan are applied as in claims 2 and 23.

The Examiner deems registration on the threading server to be inherent since the threading server must know what is connected to it in order to function. By this rationale claims 9 and 30 are rejected.

18. Regarding claims 12 and 33, Maurille and Flanagan are applied as in claims 2 and 23.

Maurille further discloses a persistent data store for said records, said persistent data store in communication with said server. [Maurille, Figure 1, items 100, 104] By this rationale claims 12 and 33 are rejected.

19. Regarding claims 13 and 34, Maurille and Flanagan are applied as in claims 12 and 33.

Maurille further discloses the persistent data store comprises a relational database. [Maurille, column 6, lines 44-57] By this rationale claims 13 and 34 are rejected.

20. Regarding claims 14 and 35, Maurille and Flanagan are applied as in claims 12 and 33.

Flanagan further discloses a standard API. [Flanagan, 17] By this rationale claims 14 and 35 are rejected.

21. Regarding claims 15 and 36, Maurille and Flanagan are applied as in claims 2 and 23.

Maurille further discloses at least one client. [Maurille, Figure 1] By this rationale claims 15 and 36 are rejected.

22. Regarding claims 16 and 37, Maurille and Flanagan are applied as in claims 15 and 36.

Maurille further discloses a servlet component instantiated on a web server, said servlet

Art Unit: 2145

component providing a link between said server and a web browser. [Maurille, column 3, lines 2-15] By this rationale claims 16 and 37 are rejected.

23. Regarding claims 18 and 39, Maurille and Flanagan are applied as in claims 15 and 36. Maurille further discloses a user interface that displays said threaded trails of communication. [Maurille, Figure 4C] By this rationale claims 18 and 39 are rejected.

24. Claims 4 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Flanagan and Kennedy (U.S. Patent No. 6,330,589).

25. Regarding claims 4 and 25, Maurille and Flanagan are applied as in claims 2 and 23. Maurille and Flanagan fail to disclose the use of placeholders.

26. However, Kennedy discloses placeholders used in a conversation thread. [Kennedy, Abstract]

27. It would be obvious to one of ordinary skill in the art to combine the teachings of Maurille, Flanagan and Kennedy for the purpose of allocating space for a message that has not been received yet and eliminating the need to rethread all conversations after every download. [Kennedy, Abstract] Maurille gives motivation for the combination by stating messages are not immediately accessible in a bulletin board system. [Maurille, column 2, lines 14-22] By this rationale claims 4 and 25 are rejected.

28. Claims 43, 44, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille and Kennedy.

29. Regarding claim 43, the limitations of this claim are substantially same as the limitations of claim 1. Maurille further discloses means for creating and accessing items of communication by a user. [Maurille, column 3, lines 49-65] Maurille fails to disclose the use of placeholders.

30. However, Kennedy discloses placeholders used in a conversation thread. [Kennedy, Abstract]

31. The motivation for combining Maurille and Kennedy is the same motivation applied to claims 4 and 25. By this rationale claim 43 is rejected.

32. Regarding claim 44, Maurille and Kennedy are applied as in claim 43. Maurille further discloses a root post and a plurality of related posts arranged in a post-response metaphor, and

Art Unit: 2145

wherein a response is associated with its parent post, so that posts and responses are displayed in a hierarchy, said root post forming the top level of the hierarchy. [Maurille, column 9, lines 1-6, Figure 4B-4C] By this rationale claim 44 is rejected.

33. Regarding claim 51 and 52, Maurille and Kennedy are applied as in claim 43. Maurille further discloses displaying a process and its component steps. [Figure 4D] By this rationale claims 51 and 52 are rejected.

34. Claims 17 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Flanagan and Official Notice.

35. Regarding claims 17 and 38, Maurille and Flanagan are applied as in claims 15 and 36. Maurille and Flanagan fail to disclose an intranet application.

36. However, Official Notice is taken that intranet applications are commonly known in the art.

37. It would be obvious to one of ordinary skill in the networking art to implement Maurille and Flanagan as an intranet application for the purposes of deployment of a collaborative message board on a corporate intranet. By this rationale claims 17 and 38 are rejected.

38. Claims 19 and 40 rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Flanagan, Kennedy and Knight et al. (U.S. Patent No. 6,571,234).

39. Regarding claims 19 and 40, Maurille and Flanagan are applied as in claims 18 and 39. Maurille discloses creating a new post, deleting a post/response item, and viewing detailed information related to a post/response item. [Maurille, column 10, lines 2-4, column 12, lines 40-43 column 12, lines 66-67] Maurille and Flanagan fail to disclose viewing a list of posts and responses in order of creation, searching a thread, viewing all posts as a collapsible hierarchy, creating a new response for any message, and the use of placeholders.

40. However, Knight discloses viewing a list of posts and responses in order of creation, searching a thread, viewing all posts as a collapsible hierarchy and creating a new response for any message. [Knight, column 2, lines 15-20, column 2, lines 25-28, column 2, lines 30-34, Figure 1D] Knight fails to disclose use of placeholders.

Art Unit: 2145

41. However, Kennedy discloses placeholders used in a conversation thread. [Kennedy, Abstract]

42. It would be obvious to one of ordinary skill in the networking art to combine the teachings of Maurille and Flanagan with Knight for the purpose of providing relevant content for a group of users. [Knight, column 4, lines 11-15] Maurille gives motivation for the combination by stating users should be able to see the content of messages without first selecting the messages.

[Maurille, column 1, lines 23-25] The motivation for combining Maurille, Flanagan, Knight and Kennedy is the same motivation applied to combining Maurille and Kennedy in claims 4 and 25. By this rationale claims 19 and 40 are rejected.

43. Regarding claims 20 and 41, Maurille, Flanagan, Knight and Kennedy are applied as in claims 19 and 40. Maurille further discloses a post/response item can be deleted by either the creator of said item or a system administrator. It would be obvious to one of ordinary skill in the networking art that since a post/response item can be deleted by either the author or a system administrator, deleting of such items can be limited to the author or a system administrator for security and administrative purposes. By this rationale claims 20 and 41 are rejected.

44. Claims 21 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille and Smith (U.S. Patent No. 6,792,448).

45. Regarding claims 21 and 42, Maurille is applied as in claims 1 and 22. Maurille fails to disclose a thread associated with a process.

46. However, Smith discloses a process for threaded discussion. [Smith, column 7, lines 49-61, Figure 4]

47. It would be obvious to one of ordinary skill in the networking art to combine the teachings of Maurille and Smith for the purpose of automatically associating a message with a thread based upon user criteria. [Smith, column 9, lines 58-63] Maurille gives motivation for the combination by stating that the client application instantly displays the content of all messages associated with conversations in which the respective user is a party. [Maurille, column 3, lines 49-54] By this rationale claims 21 and 42 are rejected.

Art Unit: 2145

48. Claims 8 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Flanagan and Sunaga et al. (U.S. Patent No. 6,094,675).

49. Regarding claims 8 and 29, Maurille and Flanagan are applied as in claims 7 and 28. Maurille and Flanagan fail to disclose storing items on an external server.

50. However, Sunaga discloses an external storage server for an electronic discussion system. [Sunaga, Abstract, Figure 1, item 130]

51. It would be obvious to one of ordinary skill in the art to combine the teachings of Maurille, Flanagan and Sunaga for the purpose of preventing the load on the main server from becoming too great from storage demands. [Sunaga, column 2, lines 5-9] Maurille gives motivation for an external storage system. [Maurille, column 3, lines 13-15] By this rationale claims 8 and 29 are rejected.

52. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Kennedy, and Sunaga.

53. Regarding claim 45, Maurille and Kennedy are applied as in claim 44. Maurille and Kennedy fail to disclose storing items on an external server.

54. However, Sunaga discloses an external storage server for an electronic discussion system. [Sunaga, Abstract, Figure 1, item 130]

55. The motivation to combine Maurille, Kennedy and Sunaga is the same motivation used to combine Maurille, Flanagan and Sunaga in claims 8 and 29. By this rationale claim 45 is rejected.

56. Claims 10 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Flanagan and Manber et al. (U.S. Patent No. 6,651,086).

57. In regard to claims 10 and 31, Maurille and Flanagan are applied as in claims 9 and 30. Maurille discloses a name and description of a type to be registered. [Maurille, column 8, lines 22-65] Maurille fails to disclose classes. However, Flanagan discloses user-definable classes in Java. [Flanagan, 17] It would be obvious to use a class for any number of reasons, including implementing a connector on a server. Maurille and Flanagan fail to disclose use of an image file. However, Manber discloses an image file to designate items of a type [chat room] to be

Art Unit: 2145

registered within a user interface. [Manber, Figure 4, item 330] It would be obvious to one of ordinary skill in the networking art to combine Manber with the teachings of Maurille and Flanagan for the purpose of an easy-to-use user interface. By this rationale claims 10 and 31 are rejected.

58. Claims 11 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Flanagan and Official Notice.

59. In regard to claims 11 and 32, Maurille and Flanagan are applied as in claims 9 and 30. Maurille and Flanagan fail to disclose listing registered communication types. However, the office takes Official Notice that a server can produce multiple listings of server information. It would be obvious to one of ordinary skill in the art to produce a listing of server information for many purposes, including listing all registered communication types on that server. By this rationale claims 11 and 32 are rejected.

60. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Kennedy, Sunaga, and Flanagan.

61. In regard to claim 46, Maurille, Kennedy and Sunaga are applied as in claim 45. Maurille, Kennedy and Sunaga fail to disclose the invocation of connectors to an external communication system. However, Flanagan has already been shown to be a way to create connectors to an external communication system in the rejection for claim 2. The motivation for combining Maurille, Kennedy and Sunaga with Flanagan is the same motivation used to combine Maurille and Flanagan in claim 2. By this rationale claim 46 is rejected.

62. In regard to claim 47, Maurille, Kennedy, Sunaga and Flanagan are applied as in claim 46. Maurille further discloses methods for interacting with an external system. [Maurille, column 3, lines 11-15]. Flanagan discloses user-definable classes in Java for any purpose [Flanagan, 17] It would be obvious to one of ordinary skill in the art to use a class for any number of reasons, including interacting with an external system. By this rationale claim 47 is rejected.

63. In regard to claim 48, Maurille, Kennedy, Sunaga and Flanagan are applied as in claim 47. Maurille further discloses accepting a request for an action and initiating the request on an external system. [Maurille, column 3, lines 2-15] By this rationale claim 48 is rejected.

Art Unit: 2145

64. In regard to claim 50, Maurille, Kennedy, Sunaga and Flanagan are applied as in claim 46. Kennedy further discloses the use of placeholders. [Kennedy, Abstract, column 13, lines 32-55] By this rationale claim 50 is rejected.

65. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille, Kennedy, Sunaga, Flanagan and Knight.

66. In regard to claim 49, Maurille, Kennedy, Sunaga and Flanagan are applied as in claim 46. Maurille discloses creating a new post, deleting a post/response item, and viewing detailed information related to a post/response item. [Maurille, column 10, lines 2-4, column 12, lines 40-43, column 12, lines 66-67] Kennedy discloses the use of placeholders. [Kennedy, Abstract] Maurille, Flanagan, Kennedy and Sunaga fail to disclose viewing a list of posts and responses in order of creation, searching a thread, viewing all posts as a collapsible hierarchy and creating a new response for any message. However, Knight discloses viewing a list of posts and responses in order of creation, searching a thread, viewing all posts as a collapsible hierarchy and creating a new response for any message. [Knight, column 2, lines 15-20, column 2, lines 25-28, column 2, lines 30-34, Figure 1D] The motivation for combining Knight with the aforementioned references is the same motivation applied to claims 19 and 40. By this rationale claim 49 is rejected.

Double Patenting

67. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2145

68. Claims 1-52 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-58 of copending Application No. 10/029,647. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

69. For example, claims 1 and 21 of the instant application are exactly the same as claim 1 of the exemplary application, describing a system for threading heterogeneous items of electronic communication into a post-response metaphor within context of a process, comprising: means for interfacing with a plurality of external communication systems of varying type; a server, said server operative to create records that uniquely identify and link communication items created by a plurality of users within any of said external communication systems whereby a threaded trail of collaborative communication is created; and means for associating said threaded trail with any of a process and a process step.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRS


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